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In re Application of :
Nancy Chang :
Application No. 06/659,339 : ON PETITION
Filed: October 10, 1984 :
Attorney Docket No. CTR84-7 :

This is a decision on the petition under 37 CFR 1.182, filed February 22, 1996, to amend the above-identified abandoned application by: (1) insertion of a reference under 35 USC 120 to application No. 06/643,306, filed August 22, 1984, and (2) insertion of a reference to the pre-filing date deposit of a recombinant phage clone, ABH-10, harboring HTLV-III DNA.

The petition to insert a reference under 35 USC 120 to application No. 06/643,306, filed August 22, 1984, is **GRANTED**.

The petition to insert a reference to the deposit of a recombinant phage clone, ABH-10, harboring HTLV-III DNA is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182."

BACKGROUND

Although instant application No. 06/659,339 ('339) was pending from October 10, 1984, through March 15, 1987, petitioner did not perfect a claim of domestic priority under 35 USC 120 for benefit of Application No. 06/643,306 ('306) which was pending from August 22, 1984, through July 14, 1987, during the pendency of the '339 application. The '306 application as filed named Robert C. Gallo (Gallo), Flossie Wang-Stall (Stall), Beatrice Hahn, and Mikulas Popovic as inventors. As filed, the '339 application named Nancy T. Chang (Chang) as sole inventor. On May 16, 1986, a petition to correct inventorship under 37 CFR 1.48 was filed, which sought to add Gallo and Stall as joint inventors with Chang. The declaration under 37 CFR 1.63 filed with the petition failed to include the claim for benefit under 35 USC 120 of the earlier '306 application, and the dates of the signatures of the newly added inventors. This petition was apparently never treated by the examiner during prosecution of the '339 application.

Moreover, although a biological material allegedly mentioned in the '339 disclosure had been previously made the subject of a deposit, the '339 specification, as filed, failed to refer to that deposit. During Chiron Corporation v. Abbott Laboratories, 902 F.Supp. 1103 (N.D. Cal. 1995), issues were raised regarding the sufficiency of the disclosure of the '339 application, under 35 USC 112. Petitioner seeks to amend the specification to perfect the claim for domestic priority, as well as to amend the specification to make reference to the deposit.

STATUTE AND REGULATION

35 USC 112, first paragraph, states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set

connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 USC 114 states:

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of the invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

35 USC 115 states, in part:

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter for which he solicits a patent; and shall state of what country he is a citizen.

35 USC 116 states, in part:

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent. . . .

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

35 USC 120 states:

An applicant for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment or of termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

35 USC 131 states:

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

35 USC 132 states:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement is made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. **No amendment shall introduce new matter into the disclosure of the invention** [emphasis added].

35 USC 133 states:

Upon the failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

37 CFR 1.48 provides, in part:

(a) If the correct inventor or inventors are not named in a nonprovisional application through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by:

(1) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred;

(2) an oath or declaration by each actual inventor or inventors as required by § 1.63;

(3) the fee set forth in § 1.17(h); and

(4) the written consent of any assignee. When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

37 CFR 1.63 provides, in part:

(a) An oath or declaration filed under § 1.51(a)(1)(ii) as a part of a nonprovisional application must:

(1) Be executed in accordance with either §§ 1.66 or 1.68;

(2) Identify the specification to which it is directed;

(3) Identify each inventor and the residence and country of citizenship of each inventor; and

(4) State whether the inventor is a sole or joint inventor of the invention claimed.

(b) In addition to meeting the requirements of paragraph (a), the oath or declaration must state that the person making the oath or declaration:

(1) Has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration ;

(2) Believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(3) Acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56. . . .

(d) In any continuation-in-part application filed under the conditions specified in 35 U.S.C. § 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, the oath or declaration must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

37 CFR 1.115 provides, in part:

The applicant may amend before or after the first examination and action and also before the second or subsequent examination or reconsideration as specified in § 1.112 or when and as specifically required by the examiner.

37 CFR 1.118 states in pertinent part:

(a) No amendment shall introduce new matter into the disclosure of an application after the filing date of the application (§ 1.53(b)). All amendments to the specification, including the claims, and the drawings filed after the filing date of the application must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure cannot be added to the application after its filing date even though supported by an oath or declaration in accordance with § 1.63 or § 1.67 filed after the filing date of the application.

(b) If it is determined that an amendment filed after the filing date of the application introduces new matter, claims containing new matter will be rejected and deletion of the new matter in the specification and drawings will be required even if the amendment is accompanied by an oath or declaration in accordance with § 1.63 or § 1.67.

OPINION

With regard to the request to amend the above-identified abandoned application by insertion of reference under 35 USC 120 to application No. 06/643,306, filed August 22, 1984:

Petitioner relies upon Sampson v. Commissioner of Patents, 195 USPQ 136 (D.D.C. 1976), as support for amending the abandoned '339 application to include a specific reference to the prior co-pending '306 application, in order to perfect a claim for benefit of the '306 filing date under 35 USC 120. Petitioner's noting Weil v. Fritz, 582 F.2d 856, 196 USPQ 600 (CCPA 1978) is apt, inasmuch as that decision considered that a failure to amend the inventive entity during prosecution, as well as a deficiency in the oath or declaration proffered with that amendment, would not be fatal to a claim for benefit of the earlier application's

filing date under 35 USC 120. Id.¹ Thus, with at least one inventor in common to both the '339 and '306 applications, 35 USC 120 is satisfied to the extent requested by petitioner. Petitioner is reminded, however, of the distinction between simply *claiming* benefit under 35 USC 120 as here, and being entitled to or *accorded* benefit under 35 USC 120. See In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995). Since, as held in Sampson, 35 USC 120 makes no distinction between active and abandoned applications, and there is no 35 USC 132 bar to this limited amendment, the request to amend the '339 application by inserting a specific reference to the '306 application No. and its filing date is granted.

With regard to the request to amend the above-identified abandoned application by insertion of a reference to the pre-filing date deposit of a recombinant phage clone, λBH-10, harboring HTLV-III DNA:

Petitioner relies upon In re Lundak, 773 F.2d 1216, 227 USPQ 90 (Fed. Cir. 1985), as support for amending the abandoned '339 application to include a reference to the deposit of the HTLV-III clone at the American Type Culture Collection (ATCC). However, neither Sampson nor Lundak stand for the proposition that an abandoned application may be amended to include for the first time a specific reference to a deposit of biological material.

The court in Sampson held that the patent statutes do not bar amendments to an abandoned application to include the technical information required to obtain a benefit under 35 USC 120. Inasmuch as this latter amendment is unrelated to references under 35 USC 120, Sampson does not authorize amendment of an abandoned application to include information concerning biological deposits. Put simply, Sampson does not authorize the Patent and Trademark Office (Office) to permit an applicant to change the invention disclosed to or introduce a concept not previously present in the specification of an abandoned

¹ An applicant's oath or declaration is not a requirement under 35 USC 120, but rather a requirement under 35 USC 115. Consequently, its sufficiency is immaterial to satisfaction of 35 USC 120. Id.

application, or to continue prosecution of an abandoned application.

Petitioner's reliance on Lundak is likewise misplaced. The specification at issue in Lundak, as filed, contained a specific reference to a deposit of the biological material, and was also held to otherwise satisfy the requirements of 35 USC 112, first paragraph. 775 F.2d at 1223, 227 USPQ at 95. The court held that merely inserting updated or clarified deposit data into that specification after filing was held not to be new matter (*i.e.*, the inserted data added nothing to the written description), and, as such, the insertions did not enlarge or limit the original disclosure in violation of 35 USC 132. Id., 227 USPQ at 96. The '339 specification, as filed, is entirely silent as to any deposit of any biological material at any location; the '339 specification contained no hint of a reference to a deposit. Petitioner has not shown why the proposed insertion of deposit data is not precisely "the shape of new matter against which section 132 was designed to guard". Id., 227 USPQ at 96.

Finally, Lundak involved a pending application, where petitioner seeks to amend the specification of an abandoned application. While a reference to a deposit of biological material in the specification does not create any presumption that such material is necessary to satisfy the provisions of 35 U.S.C. § 112 (37 CFR 1.802(c)), the purpose of the rules of practice and procedures that provide for the deposit of biological material is to facilitate compliance with 35 U.S.C. § 112 in instances in which words alone cannot sufficiently describe the invention in a reproducible manner. See MPEP 2402. An amendment to the specification of a pending application must be considered by the examiner for new matter pursuant to 35 USC 132; however, the examination of an application pursuant to 35 USC 131 *et seq.* involves pending applications. Thus, the requested amendment of this abandoned application by petition would operate to evade the examination of such amendment for new matter pursuant to 35 USC 131 and 132.

The findings of law in Chiron that the '339 specification as filed failed to satisfy the enablement and best mode requirements of 35 USC 112, first paragraph, and the finding of fact that the '339 specification as filed made no reference to a deposit, are

directly opposite to the findings of law and fact in Lundak. Consequently, the proffered insertion is precluded by 35 USC 132.

Petitioner alleges the specific mention of ABH-10 in the '339 application. Assuming, *arguendo*, that petitioner's allegation is correct, petitioner has not shown, nor is it apparent, how this constitutes a reasonably precise reference to a deposit of same. Consequently, the latter proposed amendment does not amount to a mere change in wording. See In re Fouche, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971). As such, the latter amendment which seeks to now add to the specification a reference to a deposit would be contrary to Sampson, Lundak, and 35 USC 132. See also In re Hawkins, 486 F.2d 579, 179 USPQ 163 (CCPA 1973).

Unlike the above-permitted amendment, which is merely a permissible 35 USC 120 statement, this latter amendment impermissibly attempts to incorporate by reference subject matter elsewhere set forth. Since the concept of deposit is being newly introduced, subsequent to the filing date, this may constitute the addition of new matter, which is prohibited by statute (35 USC 132) and regulation (37 CFR 1.118). Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35 USC 120 statement, and the impermissible introduction of new matter by way of incorporation by reference. The court specifically stated:

Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore "limit" the absolute and express prohibition against new matter contained in section 251 [or 132]. Id. at 688, 207 USPQ at 276.

Thus, assuming, *arguendo*, that Sampson authorizes the amendment of an abandoned application beyond the mere inclusion of a 35 USC 120 statement, 35 USC 132 remains an absolute limitation as to the scope and content of such an amendment. Consequently, granting the request to insert a 35 USC 120 statement, would in no way be inconsistent with dismissing the request to insert

deposit information, which here, may constitute the insertion of new matter. Granting the former request does not violate 35 USC 132 by carrying forward any disclosure of the '306 application into the '339 application, or by augmenting the '339 disclosure. Sampson at 137. Therefore, the request to amend the specification by insertion of a reference to a deposit of any biological material, including ABH-10, is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

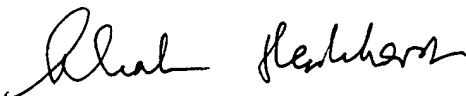
By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, VA

This application is being forwarded to the Office of the Director, Examining Group 1800, for entry, *in part*, of the amendment received February 22, 1996. Specifically, the 35 USC 120 statement will be inserted into the specification at page 1, first sentence.

Thereafter, this application will be returned to the Office of Petitions.

Telephone inquiries relative to this decision should be directed to Brian Hearn, Office of Petitions, at (703) 305-9282.



Abraham HersHKovitz, Director
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects
BH/rwb